

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bong-Jin LEE, et al.

Serial No.: 08/876,179

Filed: 13 June 1997

For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(As Amended)



Examiner: GUSHI, ROSS

Art Unit: 2833


**TRANSMITTAL OF APPELLANT'S BRIEF FEE**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Accompanying this transmittal is a check drawn to the U.S. Department of Treasury in the amount of \$300.00 for the filing a Brief in support of a Notice of Appeal on 7 June 1999. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

Respectfully submitted,

  
Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

1522 "K" Street, N.W., Suite 300  
Washington, D.C. 20005  
Area Code: 202-638-5740

Folio: P54596  
Date: 9 August 1999  
I.D.: REB/mf

RECEIVED  
AUG 11 1999  
TC 2800 MAIL ROOM

1           15.    The hard disk drive of claim 12, further comprised of said terminals being hook  
2   shaped.

1           16.    The hard disk drive of claim 12, further comprised of said terminals being V-shaped.

1           17.    The hard disk drive of claim 12, further comprised of said first connector and said  
2   second connector each being a 14 pin type of connector.

1           18.    The hard disk drive of claim 12, further comprised of said contacts and said terminals  
2   each being a 4 pin type of connector.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

BONG-JIN-LEE

Serial No.: 08/876,179

Examiner: GUSHI, ROSS

Filed: 13 June 1997

Art Unit: 2833

For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(as amended)



**PETITION UNDER 37 C.F.R. §1.181**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Applicant respectfully petitions from the failure of the Examiner in the Advisory action of 14 May 1999 (Paper No. 14) to enter Applicant's Amendment After Final filed on 15 April 1999, and as reasons therefor states that:

Folio: P54596  
Date: 8/9/99  
I.D.: REB/kf

RECEIVED  
AUG 11 1999  
TC 2800 MAIL ROOM

### STATEMENT OF FACTS

1. On June 13, 1997 Applicant filed application with 11 claims in the U.S. Patent & Trademark Office.
2. On July 22, 1998 the Examiner issued a first Office action (Paper No. 5) where all eleven (11) claims were rejected under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
3. On October 22, 1998, Applicant filed an Amendment to the outstanding Office action wherein Applicant amended Claims 1 through 8 and Claims 10 and 11, canceled Claim 9 and added Claims 12 through 18.
4. On January 5, 1999, the Examiner issued a final Office action (Paper No. 7) rejecting Claims 1 through 8 and 10 through 18 under 35 U.S.C. §112, first paragraph, 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
5. On April 5 1999, Applicant filed an Amendment under 37 C.F.R. §1.116(b) amending Claims 1, 3, 6, 8, and 12 to overcome the 35 U.S.C. §112, first and second paragraph rejections. In addition, Applicant argued the art rejections of the claims.

6. On April 16, 1999 the Examiner issued an Advisory action (Paper No. 11) where the Examiner rejected again all the claims and refused to enter any of the amendments after final.
7. On April 27, 1999 Applicant filed a Request for Consideration After Final to try to enter the amendments after final.
8. On May 14, 1999, the Examiner issued a second Advisory action (Paper No. 14) repeating his prior Advisory action by rejecting all the claims and refusing to enter any of the amendments after final.

#### **ARGUMENTS/REMARKS**

In Paper Nos. 11 and 14, the Examiner stated that all of the claims, 1 through 8 and 10 through 18 remain rejected and the Examiner refused to enter any of the amendments after final because the Examiner states:

"applicant's arguments advocating the entering of amendments after final rejection are not persuasive; the amendments regarding first and second circuit boards and automatic engagement are new matter requiring substantial consideration."

Regarding the claim that the first and second circuits board are considered new matter, Applicant points out that the claims prior to final amendments state "a printed circuit board" and "a

printed circuit board assembly." Thus, the claim already contained two separate circuit boards. This is evidenced by Claims 1, 6, and 12. For these reasons, the Examiner was in error in stating that the first and second circuit boards are new matter.

Regarding the second claim by the Examiner that automatic engagement is new matter, Applicant cites the Summary of the Invention section of the specification, page 3, lines 3 and 4 where it states, "an electrical connection between a head disk assembly in a flexible printed circuit board is automatically made upon mounting a printed circuit board on a head/disk assembly." Applicant cites original Claim 1 as filed on June 13, 1997 where it says "said second plurality of connector pins being automatically connected when said first connector is connected." Claim 6 of the originally filed application says "said second connector automatically electrically connecting said printed circuit board to said head/disk assembly when said first connector connects said printed circuit board to said head/disk assembly." Claim 9 of the originally filed application of June 13, 1997 says "said connector automatically connecting said head disk assembly to said printed circuit board when attaching said hard disk drive to said head disk assembly." Thus, it is not new matter that the term "automatic" is to be entered in the Amendment After Final in the claims.

Finally, the Examiner claims that entry of the Amendment After Final would require substantial consideration. However, Applicant quotes from the Examiner's final Office action (Paper No. 7) where he states "again, either there are two or more printed circuit boards which are not

distinguished in the claims, or there is a single circuit board which is claimed multiple times in the same claim. Independent claims 6 and 12, although worded slightly differently, have the same ambiguities." Thus, the Examiner was already aware of the fact that there might have been more than one printed circuit board in Applicant's claims and the Examiner should have been prepared to examine the possibility of more than one circuit board at the stage in prosecution.

For these reasons, Applicant contends that the Examiner's assertion that the substantial consideration will be imposed on the Examiner if the amendments after final were entered, is without merit.

**RELIEF REQUESTED**

In view of the above, the Commissioner is respectfully requested to:

- A. Enter the Amendment After Final filed by Applicant on April 5, 1999; and
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

---

Robert E. Bushnell  
Attorney for the Applicant  
Registration No.: 27,774

1522 "K" Street N.W., Suite 300  
Washington, D.C. 20005  
(202) 638-5740

Folio: P54596  
Date: 8/9/99  
I.D.: REB/kf

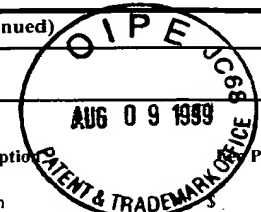


# AF/GAU  
PTO/SB/17 (2/98)  
2833

Approved for use through 9/30/2000. OMB 0651-0032  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1 style="margin: 0;">FEE TRANSMITTAL</h1> <p style="margin: 5px 0;">Patent fees are subject to annual revision on October 1. These are the fees effective October 1, 1997. Small Entity payments <u>must</u> be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12. See 37 C.F.R. §§1.27 and 1.28.</p>				<b>Complete If Known</b>																																																																																																																																																																																																																																	
				Application Number		08/876,179																																																																																																																																																																																																																															
				Filing Date		13 June 1997																																																																																																																																																																																																																															
				First Named Inventor		Bong-Jin LEE, et al.																																																																																																																																																																																																																															
				Examiner Name		GUSHI, ROSS																																																																																																																																																																																																																															
				Group/Art Unit		2833																																																																																																																																																																																																																															
TOTAL AMOUNT OF PAYMENT		(\$) <u>300.00</u>		Attorney Docket No.		P54596																																																																																																																																																																																																																															
METHOD OF PAYMENT (check one)				FEE CALCULATION (continued)																																																																																																																																																																																																																																	
1. <input type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:				3. ADDITIONAL FEES																																																																																																																																																																																																																																	
Deposit Account Number: <u>02-4943</u> Deposit Account Number: _____				<table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr> <td>105</td> <td>130</td> <td>205</td> <td>65</td> <td>Surcharge-late filing fee or oath</td> <td>\$</td> </tr> <tr> <td>127</td> <td>50</td> <td>227</td> <td>25</td> <td>Surcharge-late provisional filing fee or cover sheet</td> <td>\$</td> </tr> <tr> <td>139</td> <td>130</td> <td>139</td> <td>130</td> <td>Non-English specification</td> <td>\$</td> </tr> <tr> <td>147</td> <td>2,520</td> <td>147</td> <td>2,520</td> <td>For filing a request for reexamination</td> <td>\$</td> </tr> <tr> <td>112</td> <td>920*</td> <td>112</td> <td>920*</td> <td>Requesting publication of SIR prior to Examiner action</td> <td>\$</td> </tr> <tr> <td>113</td> <td>1,840 *</td> <td>113</td> <td>1,840*</td> <td>Requesting publication of SIR after Examiner action</td> <td>\$</td> </tr> <tr> <td>115</td> <td>110</td> <td>215</td> <td>55</td> <td>Extension for reply within first month</td> <td>\$</td> </tr> <tr> <td>116</td> <td>380</td> <td>216</td> <td>190</td> <td>Extension for reply within second month</td> <td>\$</td> </tr> <tr> <td>117</td> <td>870</td> <td>217</td> <td>435</td> <td>Extension for reply within third month</td> <td>\$</td> </tr> <tr> <td>118</td> <td>1,360</td> <td>218</td> <td>680</td> <td>Extension for reply within fourth month</td> <td>\$</td> </tr> <tr> <td>128</td> <td>1,850</td> <td>228</td> <td>925</td> <td>Extension for reply within fifth month</td> <td>\$</td> </tr> <tr> <td>119</td> <td>300</td> <td>219</td> <td>150</td> <td>Notice of Appeal</td> <td>\$</td> </tr> <tr> <td>120</td> <td>300</td> <td>220</td> <td>150</td> <td>Filing a brief in support of an appeal</td> <td>\$300</td> </tr> <tr> <td>121</td> <td>260</td> <td>221</td> <td>130</td> <td>Request for oral hearing</td> <td>\$</td> </tr> <tr> <td>138</td> <td>1,510</td> <td>138</td> <td>1,510</td> <td>Petition to institute a public use proceeding</td> <td>\$</td> </tr> <tr> <td>140</td> <td>110</td> <td>240</td> <td>55</td> <td>Petition to revive - unavoidable</td> <td>\$</td> </tr> <tr> <td>141</td> <td>1,210</td> <td>241</td> <td>605</td> <td>Petition to revive - unintentional</td> <td>\$</td> </tr> <tr> <td>142</td> <td>1,210</td> <td>242</td> <td>605</td> <td>Utility issue fee (or reissue)</td> <td>\$</td> </tr> <tr> <td>143</td> <td>430</td> <td>243</td> <td>215</td> <td>Design issue fee</td> <td>\$</td> </tr> <tr> <td>144</td> <td>580</td> <td>244</td> <td>290</td> <td>Plant issue fee</td> <td>\$</td> </tr> <tr> <td>122</td> <td>130</td> <td>122</td> <td>130</td> <td>Petitions to the Commissioner</td> <td>\$</td> </tr> <tr> <td>123</td> <td>50</td> <td>123</td> <td>50</td> <td>Petitions related to provisional applications</td> <td>\$</td> </tr> <tr> <td>126</td> <td>240</td> <td>126</td> <td>240</td> <td>Submission of Information Disclosure Statement</td> <td>\$</td> </tr> <tr> <td>581</td> <td>40</td> <td>581</td> <td>40</td> <td>Recording each patent assignment per property (Times number of properties)</td> <td>\$</td> </tr> <tr> <td>146</td> <td>760</td> <td>246</td> <td>380</td> <td>Filing a submission after final rejection (37 C.F.R. §1.129(a))</td> <td>\$</td> </tr> <tr> <td>149</td> <td>760</td> <td>249</td> <td>380</td> <td>For each additional invention to be examined (37 C.F.R. §1.129(b))</td> <td>\$</td> </tr> <tr> <td colspan="4">Other Fee (specify) _____</td> <td colspan="2">\$</td> </tr> <tr> <td colspan="4">Other Fee (specify) _____</td> <td colspan="2">\$</td> </tr> <tr> <td colspan="4"> <b>** Reduced by Basic Filing Fee Paid</b> </td> <td colspan="2"> <b>SUBTOTAL (3)</b> </td> </tr> <tr> <td colspan="4"></td> <td colspan="2" style="text-align: right;">\$300.00</td> </tr> <tr> <td colspan="6" style="text-align: center;">SUBMITTED BY</td> <td colspan="2" style="text-align: center;">Complete (if applicable)</td> </tr> <tr> <td colspan="2">Typed or Printed Name</td> <td colspan="3">Robert E. Bushnell, Esq.</td> <td colspan="2">Reg. Number</td> <td>27,774</td> </tr> <tr> <td colspan="2">Signature</td> <td colspan="2"> </td> <td colspan="2">Date</td> <td colspan="2">9 August 1999</td> </tr> <tr> <td colspan="2"></td> <td colspan="2"></td> <td colspan="2">Deposit Account User ID</td> <td colspan="2"></td> </tr> </tbody></table>				Large Entity		Small Entity		Fee Description	Paid	Fee Code	Fee (\$)	Fee Code	Fee (\$)	105	130	205	65	Surcharge-late filing fee or oath	\$	127	50	227	25	Surcharge-late provisional filing fee or cover sheet	\$	139	130	139	130	Non-English specification	\$	147	2,520	147	2,520	For filing a request for reexamination	\$	112	920*	112	920*	Requesting publication of SIR prior to Examiner action	\$	113	1,840 *	113	1,840*	Requesting publication of SIR after Examiner action	\$	115	110	215	55	Extension for reply within first month	\$	116	380	216	190	Extension for reply within second month	\$	117	870	217	435	Extension for reply within third month	\$	118	1,360	218	680	Extension for reply within fourth month	\$	128	1,850	228	925	Extension for reply within fifth month	\$	119	300	219	150	Notice of Appeal	\$	120	300	220	150	Filing a brief in support of an appeal	\$300	121	260	221	130	Request for oral hearing	\$	138	1,510	138	1,510	Petition to institute a public use proceeding	\$	140	110	240	55	Petition to revive - unavoidable	\$	141	1,210	241	605	Petition to revive - unintentional	\$	142	1,210	242	605	Utility issue fee (or reissue)	\$	143	430	243	215	Design issue fee	\$	144	580	244	290	Plant issue fee	\$	122	130	122	130	Petitions to the Commissioner	\$	123	50	123	50	Petitions related to provisional applications	\$	126	240	126	240	Submission of Information Disclosure Statement	\$	581	40	581	40	Recording each patent assignment per property (Times number of properties)	\$	146	760	246	380	Filing a submission after final rejection (37 C.F.R. §1.129(a))	\$	149	760	249	380	For each additional invention to be examined (37 C.F.R. §1.129(b))	\$	Other Fee (specify) _____				\$		Other Fee (specify) _____				\$		<b>** Reduced by Basic Filing Fee Paid</b>				<b>SUBTOTAL (3)</b>						\$300.00		SUBMITTED BY						Complete (if applicable)		Typed or Printed Name		Robert E. Bushnell, Esq.			Reg. Number		27,774	Signature				Date		9 August 1999						Deposit Account User ID			
Large Entity		Small Entity		Fee Description	Paid																																																																																																																																																																																																																																
Fee Code	Fee (\$)	Fee Code	Fee (\$)																																																																																																																																																																																																																																		
105	130	205	65	Surcharge-late filing fee or oath	\$																																																																																																																																																																																																																																
127	50	227	25	Surcharge-late provisional filing fee or cover sheet	\$																																																																																																																																																																																																																																
139	130	139	130	Non-English specification	\$																																																																																																																																																																																																																																
147	2,520	147	2,520	For filing a request for reexamination	\$																																																																																																																																																																																																																																
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	\$																																																																																																																																																																																																																																
113	1,840 *	113	1,840*	Requesting publication of SIR after Examiner action	\$																																																																																																																																																																																																																																
115	110	215	55	Extension for reply within first month	\$																																																																																																																																																																																																																																
116	380	216	190	Extension for reply within second month	\$																																																																																																																																																																																																																																
117	870	217	435	Extension for reply within third month	\$																																																																																																																																																																																																																																
118	1,360	218	680	Extension for reply within fourth month	\$																																																																																																																																																																																																																																
128	1,850	228	925	Extension for reply within fifth month	\$																																																																																																																																																																																																																																
119	300	219	150	Notice of Appeal	\$																																																																																																																																																																																																																																
120	300	220	150	Filing a brief in support of an appeal	\$300																																																																																																																																																																																																																																
121	260	221	130	Request for oral hearing	\$																																																																																																																																																																																																																																
138	1,510	138	1,510	Petition to institute a public use proceeding	\$																																																																																																																																																																																																																																
140	110	240	55	Petition to revive - unavoidable	\$																																																																																																																																																																																																																																
141	1,210	241	605	Petition to revive - unintentional	\$																																																																																																																																																																																																																																
142	1,210	242	605	Utility issue fee (or reissue)	\$																																																																																																																																																																																																																																
143	430	243	215	Design issue fee	\$																																																																																																																																																																																																																																
144	580	244	290	Plant issue fee	\$																																																																																																																																																																																																																																
122	130	122	130	Petitions to the Commissioner	\$																																																																																																																																																																																																																																
123	50	123	50	Petitions related to provisional applications	\$																																																																																																																																																																																																																																
126	240	126	240	Submission of Information Disclosure Statement	\$																																																																																																																																																																																																																																
581	40	581	40	Recording each patent assignment per property (Times number of properties)	\$																																																																																																																																																																																																																																
146	760	246	380	Filing a submission after final rejection (37 C.F.R. §1.129(a))	\$																																																																																																																																																																																																																																
149	760	249	380	For each additional invention to be examined (37 C.F.R. §1.129(b))	\$																																																																																																																																																																																																																																
Other Fee (specify) _____				\$																																																																																																																																																																																																																																	
Other Fee (specify) _____				\$																																																																																																																																																																																																																																	
<b>** Reduced by Basic Filing Fee Paid</b>				<b>SUBTOTAL (3)</b>																																																																																																																																																																																																																																	
				\$300.00																																																																																																																																																																																																																																	
SUBMITTED BY						Complete (if applicable)																																																																																																																																																																																																																															
Typed or Printed Name		Robert E. Bushnell, Esq.			Reg. Number		27,774																																																																																																																																																																																																																														
Signature				Date		9 August 1999																																																																																																																																																																																																																															
				Deposit Account User ID																																																																																																																																																																																																																																	



RECEIVED  
 AUG 11 1999  
 TC 2800 MAIL ROOM